

REMARKS

The Applicant's have given careful consideration to the Office Action mailed July 15, 2003. In view of the arguments made herein, reexamination and reconsideration of the application are respectfully requested. **Claims 1-22** remain in the application. **Claim 23** has been added.

The Office Action

In the Office Action mailed July 15, 2003:

claims 1-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,411,940 to Egendorf ("Egendorf") in view of U.S. Patent No. 5,956,391 to Melen ("Melen") and further in view of U.S. Patent No. 6,493,685 to Ensel ("Ensel");

claims 1-19 were further rejected under 35 U.S.C. §112, second paragraph, for failing to point out and precisely claim what the Applicants regard as the invention.

The References are Non-Analogous Art

The claims of the present application are directed toward a configurable billing system for a machine, such as, for example, a document processing system. The machine outputs or produces a product or service. Document processors or document processing systems produce printed matter such as original documents or copies of documents.

Egendorf is directed to an Internet billing method. When a customer orders a product or service over the Internet from a vendor, transactional information transmitted between the customer and the vendor is also transmitted to a service provider. The provider then bills the transaction amount to the customer and remits a portion of the transaction amount to the vendor, keeping the differential as a fee for providing the service. Egendorf is unrelated to a configurable billing system for a machine. Egendorf is unrelated to a configurable billing system for a document processing system. Egendorf is unrelated to a document processing system.

Melen discloses a method of identifying a dial-up Internet user for the purposes of billing purchases to the user. Features of an intelligent network are used to identify the caller or Internet user (it is submitted that this is a reference to caller I.D.). This information is associated with an IP-address of the Internet user thereby allowing even a

temporarily assigned IP-address to be used to identify the dial-up internet user for the purposes of billing the Internet user for purchases.

Melen is unrelated to a configurable billing system for a machine. Melen is unrelated to a configurable billing system for a document processing system and Melen is unrelated to a document processing system.

Ensel is directed to an electronic account presentation and response system and method. An information interface provider (IIP) acts as an interface between a biller and its customers for both the presentment of electronic bills to the customers and for the processing of payments from the biller's customers. Ensel is unrelated to a configurable billing system for a machine, a configurable billing system for a document processing system, or a document processing system.

One concerned with generating billing information based on activities of a machine used in the production of a product or service would not look to Egendorf, Melen or Ensel. Therefore Egendorf, Melen and Ensel are non-analogous art and are not fairly combined against the claims of the present application.

The Claims are Unanticipated and Unobvious

Claims 1-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Egendorf in view of Melen and further in view of Ensel. In making this rejection, the Office Action asserts that the references disclose various procedures and various objects without reference to elements recited in the claims of the present application. Clarification is respectfully requested.

Claim 1 recites a configurable billing system for a machine, the machine operative to output a product or service and including a plurality of aspect sensors, the sensors operative to detect delivery of aspects of the product or service and to report delivery to the billing system, the billing system comprising a coded billing strategy defined for the machine and the plurality of meters updated by the billing system for recording the delivery of aspects of the product or service based on the billing strategy whereby the billing system tallies the aspects in a predefined manner.

The Office Action asserts that Egendorf discloses billing different accounts with different strategies and that Ensel discloses a plurality of means for recording the delivery of aspects of products from billers and directs the attention of the Applicants to col. 6, lines 22-60 of Egendorf and FIG. 1 reference numerals 5, 10 and 15 of Ensel in support of these assertions. However, while Egendorf discloses billing different

accounts it is unclear to the Applicants which part of the referenced section the Office Action considers to be disclosure of --different strategies--. Even if Egendorf discloses different strategies associated with sending billing information to different accounts, Egendorf does not disclose or suggest a coded billing strategy defined for a machine. FIG. 1 of Ensel is a schematic diagram illustrating the data flows between the billers, the information interface provider and channels of distribution (col. 5, lines 35-38). Reference numerals 5, 10 and 15 refer to billers (col. 6, line 15). It is respectfully submitted that disclosure of billers is not disclosure of a plurality of meters updated by the billing system for recording the delivery of aspects of the products or service based on the billing strategy defined for a machine whereby the billing system tallies the aspects in a predefined manner.

Additionally, as explained above, Egendorf and Ensel are non-analogous art.

For the foregoing reasons, **claim 1**, as well as **claims 2-5**, which depend therefrom, is unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

Furthermore, **claim 2** recites wherein the coded billing strategy comprises a list of aspects of interest. The Office Action provides no specific rejection of **claim 2**. It is unclear which part of the rejection of **claims 1-22** might be directed toward **claim 2**. However, the Office Action asserts that Egendorf discloses a descriptor of items and directs the attention of the Applicants to col. 3, lines 11-25 in support of that assertion. The Applicants assume this is the portion of the rejection directed at **claim 2**. However, the referenced section explains that a customer can browse the Internet or a web page until an item is located that the customer wishes to purchase, at which time the customer will follow the instructions created by the vendor, exchange transactional information, and ultimately agree to purchase something by taking an appropriate action. It is respectfully submitted that this is not a disclosure or a suggestion of a coded billing strategy comprising a list of aspects of interest.

For the foregoing additional reasons, **claim 2** is unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

Claim 3 recites the coded billing strategy comprises a list of meters. **Claim 4** recites the coded billing strategy comprises information associated with the listed meters, the information describing the function of the meters. The Office Action provided no specific rejection of **claims 3 and 4**. Additionally, the Applicants have carefully reviewed the Office Action and can find no portion that appears to be directed to **claims**

3 and 4. Furthermore, it is respectfully submitted that the references simply do not disclose or suggest a coded billing strategy comprises a list of meters or that the coded billing strategy comprises information associated with the listed meters, the information describing the function of the meters.

For the foregoing additional reasons, **claims 3 and 4** are unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

Claim 5 recites the coded billing strategy comprises information representing a set of functions describing the function of a set of meters. The Office Action provided no specific rejection of **claim 5**. Additionally, the Applicant's have reviewed the Office Action and can find no portion that appears to be directed toward **claim 5**. Furthermore, it is respectfully submitted that the references do not disclose or suggest a coded billing strategy comprising information representing a set of functions describing the operation of a set of meters.

For the foregoing additional reasons, **claim 5** is unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

Claim 6 recites a configurable billing system for a document processing system, the document processing system operative to produce documents and including a plurality of aspect sensors operative to detect document production events to report the aspects of the document production to the billing system, the billing system comprising a billing strategy description accessible by the billing system, a plurality of meters defined in the billing strategy, and a billing module operative to update the plurality of meters according to the billing strategy. The Office Action provides no specific reason for the rejection of **claim 6**. It is respectfully submitted that none of the cited references are directed to a document processing system or a configurable billing system therefore. None of the cited references are directed to a document processing systems operative to produce documents and none of the cited references disclose or suggest document processing systems including a plurality of aspect sensors operative to detect document production events and to report the aspects of the document production to a billing system. Additionally, arguments similar to those submitted in support of **claims 1-5** are submitted in support of **claim 6**.

For the foregoing reasons, **claim 6**, as well as **claims 7-15**, which depend therefrom, is unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

Claim 7 recites the billing strategy description comprises a list of aspects of interest. Arguments similar to those submitted in support of **claim 2** are submitted in support of **claim 7**.

For the foregoing additional reasons, **claim 7** is unanticipated and unobvious in light of Egendorf, Melen, and Ensel taken alone or in any combination.

Claim 8 recites the list of aspects of interest comprises an impression count. The Office Action provides no specific reason for rejecting **claim 7**. However, the Office Action asserts that Egendorf discloses an impression and directs the attention of the Applicants to col. 5, lines 25-28. However, col. 5, lines 25-28 of Egendorf read as follows, "when one of customers 4.1-4.N makes the decision to order a product or service from one of the vendors 5.1-5.N, 6.1-6.N and 8.1-8.N, in step 13 an exchange of transactional information occurs between the customer and the vendor". It is respectfully submitted that this is not disclosure of an impression. Furthermore, it is respectfully submitted that Egendorf does not disclose or suggest a list of aspects in a billing strategy comprises an impression count. An impression count is, for example, the number of pages printed or copied in a print job of a document processing system. The references are simply unrelated to document processing systems and billing strategies that include an impression count.

For the foregoing additional reasons, **claim 8** is unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

Claim 9 recites the list of aspects of interest comprises an impression event flag. Arguments similar to those submitted in support of **claim 8** are submitted in support of **claim 9**. An impression flag is used to indicate that a marker module has issued commands to a print engine causing the print engine to print an image on, for example, one side of a piece of paper (an impression on the other side of the piece of paper would count as a second impression) (page 6, lines 13-23). Egendorf, Melen and Ensel simply do not disclose or suggest a configurable billing system for a document processing system including a billing strategy description comprising a list of aspects of interest wherein the list of aspects of interest includes an impression event flag.

For the foregoing additional reasons, **claim 9** is unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

Claim 10 recites the list of aspects of interest comprises a set count. A set is, for example, some logical grouping of document pages. For instance, a set is a collection of document pages on which a finishing step is performed such as stapling or shrink-

wrapping. A set count is, for example, a running total of completed sets. Alternatively a set count is a grand total of sets completed in a job (page 6, line 24-page 7, line 4). Egendorf, Melen and Ensel's simply do not disclose or suggest a configurable billing system for a document processing system including a billing strategy description wherein the billing strategy description includes a list of aspects of interest and in the list of aspects of interest includes a set count.

For the foregoing additional reasons, **claim 10** is unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination. **Claim 11** recites the list of aspects of interest comprises a set completion flag. Arguments similar to those submitted in support of **claim 10** are submitted in support of **claim 11**.

Claim 12 recites the list of aspects of interest comprises a diagnostic impression flag. A diagnostic impression flag indicates, for example, that an impression is a diagnostic impression, ordered, for example, by a service technician. In some cases, customers are not charged for diagnostic impressions (page 7, lines 4-6). The Office Action provided no specific reason for rejecting **claim 12**. It is respectfully submitted that Egendorf, Melen and Ensel do not disclose or suggest a configurable billing system including a billing strategy description including a list of aspects of interest wherein the list of aspects of interest includes a diagnostic impression flag.

For the foregoing additional reasons, **claims 11 and 12** are unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

Claim 13 recites the list of aspects of interest comprises a media descriptor. A media descriptor indicates, for example, the kind of media an impression is made on. For example, a media descriptor indicates that large paper is used or that a sheet of velum is marked or that regular paper is being printed on (page 7, lines 7-10). Egendorf, Melen and Ensel do not disclose or suggest a billing system for a document processing system including a billing strategy description comprising a list of aspects of interest wherein the list of aspects of interest comprises a media descriptor.

For the foregoing additional reasons, **claim 13** is unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

Claim 14 recites the list of aspects of interest comprises a highlight color flag. The Office Action provides no specific reason for the rejection of **claim 14**. A highlight color flag indicates when highlight color is included in an impression (page 7, line 10). Egendorf, Melen and Ensel simply do not disclose or suggest a configurable billing system for a document processing system including a billing strategy description

comprising a list of aspects of interests wherein the list of aspects of interest includes a highlight color flag.

For, the foregoing additional reasons **claim 14** is unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

Claim 15 recites the list of aspects of interest comprises the full color flag. The Office Action provides no specific reason for the rejection of **claim 15**. A full color flag indicates when an impression includes full color markings (page 7, lines 10-11). It is respectfully submitted that Egendorf, Melen and Ensel do not disclose or suggest a configurable billing system for a document processing system including a billing strategy description comprising a list of aspects of interest wherein the list of aspects of interest includes a full color flag.

For the foregoing additional reasons, **claim 15** is unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

Claim 16 recites a document processing system comprising a print engine, a configurable billing system operative to follow a billing strategy and to record the occurrence of document production events described in the billing strategy and a marker module operative to control the print engine in the production of documents and to report document production events to the billing system. The Office Action provides no specific reason for the rejection of **claim 16**. However, the Office Action asserts that Melen teaches that billing information is output at a terminal which maybe a printer and directs the attention of the Applicants to FIG. 4 in support of this assertion. The Applicants assume this is related to the rejection of **claim 16**. However, FIG. 4 of Melen presents a flow chart of one embodiment of the invention of Melen. FIG. 4 outlines the steps of identifying the terminal user interface data and connecting to each other the A-number and the address of the terminal. FIG. 4 does not disclose that billing information is output at a terminal nor does Melen disclose or suggest that the terminal may be a printer. For example, see FIG. 1, which it is submitted, depicts terminals 1 and 2 as computers including keyboards and monitors. The terminals 1 and 2 are connected to the public telephone network (PSTN) and have access to an Internet connecting node by dialing a service number (Abstract, lines 1-3). It is respectfully submitted and Melen does not disclose or suggest that a printer is connected to a public telephone network having access to an Internet connecting node by dialing a service number. Even if Melen does disclose a terminal which may be a printer, Melen does not disclose or suggest that the print engine and a marker module operative to control the print engine in the

production of documents, and to report document production events to a billing system. Even if Ensel discloses a configurable billing system, Ensel does not disclose or suggest a configurable billing system operative to follow a billing strategy and to record the occurrence of document production events described in the billing strategy.

For the foregoing reasons, **claim 16**, as well as **claims 17 and 18**, which depend therefrom are unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

Claim 17 recites the marker module is operative to deliver the billing strategy to the billing system. The Office Action provides no specific explanation for the rejection of **claim 17**. It is respectfully submitted that Egendorf, Melen and Ensel do not disclose or suggest a document processing system wherein a marker module is operative to deliver a billing strategy to the billing system.

For the foregoing additional reasons, **claim 17** is unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

Claim 18 recites the print engine further comprises a xerographic printer. The Office Action provides no specific reason for the rejection of **claim 18**. Egendorf, Melen, and Ensel do not disclose or suggest a document processing system includes a xerographic printer.

For the foregoing additional reasons, **claim 18** is unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

Claim 19 has been amended to correct typographical errors. **Claim 19** recites a method for developing and using a universal billing module, the method comprising predefining a billing strategy, the billing strategy including a list of parameters with implicit or explicit communication mechanisms and data parsing information, and process algorithm information, storing the billing strategy in machine readable form, reading the stored billing strategy, instantiating meter data structures as directed by the billing strategy, monitoring a document processing procedure as directed by the read billing strategy, and updating the meter data structures as directed by the read billing strategy. The Office Action provided no specific reason for rejecting **claim 19**. Furthermore, the Office Action provides no suggestion that any of the references disclose or suggest predefining a billing strategy, the billing strategy including a list of parameters with implicit or explicit communication mechanisms and data parsing information and process algorithm information or reading a stored billing strategy or instantiating meter data structures as directed by a read billing strategy or monitoring a

document processing procedure as directed by the read billing strategy or updating the meter data structures as directed by the read billing strategy.

For the foregoing reasons, **claim 19** is unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

Claim 20 recites a configurable billing system for a machine, the machine operative to output a product or service and including a plurality of aspect sensors, the sensors being operative to detect the delivery of aspects of the product or service and to report the delivery to the billing system, the billing system comprising a means for loading a custom billing strategy, a custom billing strategy defined for the machine, a plurality of meters instantiated by the billing system for recording the delivery of the aspects of the product or service based on the billing strategy whereby the billing system tallies the aspects in a predefined manner. The Office Action provides no specific reason for the rejection of **claim 20**. Furthermore, the Applicant's have carefully reviewed the Office Action and can find no suggestion that the cited references disclose a means for loading a custom billing strategy, a custom billing strategy defined for a machine or a plurality of meters instantiated by the billing system. Arguments similar to those submitted in support of **claim 1**, **claim 6** and **claim 19** are submitted in support of **claim 20**.

For the foregoing reasons, **claim 20** is unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

Claim 21 has been amended to correct a typographical error and to correct antecedents. **Claim 21** recites a configurable billing system for a document processing system, the document processing system operative to produce documents and including one or more aspect sensor operative to detect document production events and to report the document production events to the billing system, the billing system comprising a billing strategy description accessible by the billing system defining meters as mathematical functions of information received from the one or more aspect sensors, a plurality of meters defined in the billing strategy and a billing module operative to update the plurality of meters according to the functions defined in the billing strategy. Egendorf is directed to an Internet billing method. Melen is directed to billing in the Internet. Ensel is directed to an electronic account presentation and response system and method wherein an information interface provider acts as an interface between a biller and its customers for both the presentment of electronic bills to the customer and for the processing of payments from the biller's customers. The information interface provider

creates and electronically publishes bills to the biller's customers in response to data provided by the biller and processes the payments in response to instructions provided by the customers (abstract).

It is respectfully submitted that none of the cited references are directed to a document processing system or a configurable billing system therefore. Additionally, the Office Action provides no specific reasons for the rejection of **claim 21**. While the Office Action asserts that Ensel teaches a configurable billing system, the Office Action merely directs the attention of the Applicants to FIG. 1, reference numerals 5, 10 and 15 in support of the assertion. As explained above, the disclosure of billers is not a disclosure of a configurable billing system, or a billing strategy description, accessible by the billing system defining meters as mathematical functions of information received from one or more aspect sensors or a plurality of meters defined in the billing strategy.

For the foregoing reasons, **claim 21** is unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

Claim 22 recites a document processing system comprising a print engine, a configurable billing system operative to receive a billing strategy and to record the occurrence of document production events described in the billing strategy and a marker module operative to control the print engine in the production of documents and to report the document production events to the billing system. The Office Action provides no specific reason for the rejection of **claim 22**. As explained above, it is respectfully submitted that none of the cited references disclose or suggest a document processing system as disclosed and claimed in the present application. The Office Action asserts that Melen discloses a terminal and that the terminal may be a printer. However, as explained above, Melen does not disclose or suggest that the terminal may be a printer. Furthermore, it is respectfully submitted that the terminal may not be a printer because the terminal is described as a user interface which is used to make purchases (col. 4, lines 13-18) and, it is respectfully submitted the one cannot make purchases over the Internet using a printer. Furthermore, even if Melen teaches a terminal that may be a printer, Melen does not disclose or suggest the print engine and/or a marker module operative to control the print engine in the production of documents and to report document production events to a billing system. Additionally, even if Ensel discloses a configurable billing system, Ensel does not disclose or suggest a configurable billing system operative to receive a billing strategy and to record the occurrence of document production events described in the billing strategy.

For the foregoing reasons, **claim 22** is unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

New **claim 23** recites a document processor operative to produce printed documents, the document processor comprising a print engine, at least one aspect sensor operative to sense and report at least one of an impression count, an impression event, a set count, a set completion event, a diagnostic impression event, a media description, a use of highlight color and a use of full color related to a production of a document, a billing strategy file defining a billing strategy in machine readable form, the billing strategy describing at least one mathematical function of at least one meter for processing and recording information reported by at least one aspect sensor, a billing module operative to receive the billing strategy file and instantiate at least one meter according to the billing strategy and a marker module operative to control the print engine in the production of the document. New **claim 23** is supported throughout the specification including the claims and should not require a new search. For example, **claim 16** recites a print engine and a marker module. **Claim 6** recites aspect sensors operative to detect document production events and to report the aspects of the document production to a billing system, a billing strategy description accessible by the billing system, a plurality of meters defined in the billing strategy and a billing module operative to update the plurality of meters according to the billing strategy. **Claim 7** recites that the billing strategy description comprises a list of aspects of interest and **claims 8-15** recite that the list of aspects of interest comprises an impression count, an impression event flag, a set count, a set completion flag, a diagnostic impression flag, a media descriptor, a highlight color flag, and a full color flag respectively. **Claim 19** recites storing the billing strategy in machine readable form and instantiating meter data structures as directed by the billing strategy and updating the meter data structures. Additionally, **claim 23** is supported throughout the specification and page 5, line 10 – page 7, line 14 in particular.

As explained above, the cited references alone or in combination do not disclose or suggest a document processor operative to produce printed documents. Moreover, the cited references, alone or in combination do not disclose or suggest a print engine, at least one aspect sensor operative to sense and report at least one of an impression count, an impression event, a set count, a set completion event, a diagnostic impression event, a media description, a use of highlight color and a use of full color related to a production of a document. Furthermore, even if Egendorf and Ensel disclose billing different

accounts with different strategies or configurable billing systems as asserted by the Office Action, they do not disclose or suggest a billing strategy file defining billing strategy in machine readable form, the billing strategy describing at least one mathematical function of at least one meter for processing and recording information reported by at least one aspect sensor.

For the foregoing reasons, new **claim 23** is unanticipated and unobvious in light of Egendorf, Melen and Ensel taken alone or in any combination.

**The Claims Point Out and Precisely Claim What Applicants Regard As the
Invention**

The rejection of **claims 1-19** under 35 U.S.C. §112, second paragraph made in the first Office Action is repeated in the present Office Action, even though the Applicants explained in their response to the first Office Action that the measure as to whether a claim is too broad or not is whether or not a claim reads on a prior art reference or is obvious in light of a prior art reference, and with regard to delineating and precise detail the algorithms defining the function of billing meters, there is no such requirement in the patent laws.

For the foregoing reasons, **claims 1-19** point out and precisely claim what the Applicants regard as the invention

The present Office Action repeats this rejection without responding to the arguments made by the Applicants in the previous amendment with regard to the same 35 U.S.C. §112, second paragraph rejections. Therefore, there is no clear issue developed between the Examiner and the Applicant with regard to the 35 U.S.C. §112 rejections.

It is respectfully submitted, that before final rejection is in order, a clear issue should be developed between the Examiner and the Applicant. The Examiner should never lose sight of the fact that in every case the Applicant is entitled to a full and fair hearing, and that a clear issue between the Applicant and the Examiner should be developed, if possible, before appeal (MPEP 706.07). Therefore, it is submitted that the finality of the present rejections should be withdrawn.

Telephone Interview

In the interests of advancing this application to issue and compact prosecution, the Applicant respectfully requests that the Examiner telephone the undersigned to

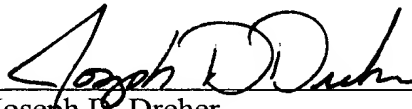
discuss any of the foregoing with which there may be some controversy or confusion or to make any suggestions that the Examiner may have to place the case in condition for allowance.

CONCLUSION

Claims 1-22 remain in the application. **Claim 23** has been added. For the foregoing reasons, the case is in condition for allowance. Accordingly, an early indication thereof is requested.

Respectfully submitted,

FAY, SHARPE, FAGAN,
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A handwritten signature in black ink, appearing to read "Joseph D. Dreher", is written over a horizontal line.

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